

Panel Decision for dispute CAC-ADREU-008455**Case number** CAC-ADREU-008455**Time of filing** 2022-12-20 09:46:02**Domain names** ATSelectrolube.eu**Case administrator****Organization** Iveta Špiclová (Czech Arbitration Court) (Case admin)**Complainant****Organization** Stephanian Holdings Inc.**Complainant representative****Organization** LDS Łazewski Depo i Wspólnicy sp. k.**Respondent****Name** Mr. Rūdis Berzins

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is not aware of any other legal proceedings which are pending or decided, and which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant belongs to the A.T.S Electro-Lube Group (the "Group"). As evidenced by the materials submitted by the Complainant, it is the proprietor of the EUTM-010201771 "A.T.S Electro-Lube" since 2011 (the "Trademark"). The Trademark registration covers class 7 of the Nice classification (*lubricant dispenser for machinery*). As shown by the Complainant, the Group has been active in the market for automatic lubrication systems for almost 40 years. The Group companies operate worldwide, including in many countries of the EU.

Respondent has registered the domain <ATSelectrolube.eu> (the "Domain"). The Domain automatically redirects to pornographic websites operating under various domain names (e.g. <bustygirls4U.com>, <fantasticdating.life>, <qxjan.astonishingdate.net>). Also, a Google search of the keyword "ATSelectrolube.eu" delivers links to various pornographic websites as the first search results.

The Complainant has submitted the Complaint requesting revocation of the Domain.

The Respondent has not filed a Response.

A. COMPLAINANT

The Complainant submits that the Domain is identical to a trademark in which the Complainant has rights – Article 4(4) of the Regulation (EU) No 2019/517 on the implementation and functioning of the .eu top-level domain name and amending and repealing Regulation (EC) No 733/2002 and repealing Commission Regulation (EC) No 874/2004 (the "Regulation"). As established in the past case law of ADR.eu panels, the difference of dots and hyphens in a domain name does not affect the way the public perceives the signs, particularly when a sign is used as a domain name. The Complainant also claims that the word element of the Trademark- "ELECTROLUBE" - is distinctive and refers, among others, to one of the first products launched by the Group in 1982, i.e. Electro-Luber.

The Complainant claims that the Respondent has registered the Domain in bad faith; namely, the Respondent has chosen the Domain to create an impression of association with the Complainant while being aware of the Complainant's rights in the Trademark. Further, the Respondent's use of the Domain (leading to websites with pornographic content) is such that it deceives Internet users into thinking that the site they are trying to access is legitimate and so causes redirection of the traffic intended for the Complainant's website <https://www.atselectrolube.com>. The redirection of the Domain website to various websites of pornographic content is probably done with the purpose of earning click-through revenues from Internet users searching for the Complainant's website, especially considering that the respective adult sites appear to be commercial in nature. The Complainant also argues that the Respondent's use of the Domain in said manner disrupts the Complainant's business and may reduce the number of visitors to the Complainant's website, therefore adversely affecting the Complainant's business.

The Complainant also points out that the use and exploitation of trademarks to obtain click-through redirection to websites with sexual content have been found

to qualify as bad faith also in previous ADR.eu panel decisions (e.g., cases involving domains senmotic.eu, baylor.eu, bormiolirocco.eu).

Based on the above, the Complainant argues that Respondent's use of the Domain constitutes bad faith in terms of paragraph B(11)(f)(4) of the .eu Alternative Dispute Resolution Rules (the "ADR Rules").

The Complainant also argues that the Respondent registered the Domain without rights or legitimate interest. With reference to paragraph B11(e) of the ADR Rules, the Complainant submits that neither it nor any member of the Group has ever granted any licence or consent to the Respondent to use any of their trademarks. There is also no evidence of Respondent's use of the Domain in connection with the offering of goods or services. The Respondent's use of the Domain is neither a legitimate non-commercial use nor fair use. The Respondent is also not commonly known by the Domain or the sign "ATSelectrolube". Respondent's registration of the Domain has adversely affected the Complainant by creating difficulties for market access and misleading consumers as well as by negatively affecting the good reputation of the Complainant and its product due to association with pornographic content.

B. RESPONDENT

The Respondent did not file a Response.

DISCUSSION AND FINDINGS

In consideration of the facts and the Parties' contentions, the Panel comes to the following conclusions:

Pursuant to Article 4(4) of the Regulation, a domain name may be revoked following an appropriate ADR or judicial procedure, in accordance with the principles and procedures on the functioning of the .eu TLD laid down pursuant to Article 11, where that name is identical or confusingly similar to a name in respect of which a right is established by Union or national law, and where it:

- (a) has been registered by its holder without rights or legitimate interest in the name; or
- (b) has been registered or is being used in bad faith.

The Panel has verified that the Complainant is indeed the proprietor of the Trademark and thus holds exclusive rights pertaining to the said mark. The Panel accepts that the Domain is identical to a name in respect of which the Complainant has rights recognised by EU law by virtue of the Trademark. The gTLD .eu suffix in the Domain should be disregarded since it is a technical requirement of registration. The Panel agrees that the difference between dots and hyphens in the Trademark compared to the Domain does not affect the way the public perceives the signs (the Domain *versus* the Trademark), particularly when a sign is used as a domain name. For the eye of an average consumer, these two words (ATSelectrolube.eu *versus* "A.T.S Electro-Lube") appear to be identical.

The Respondent has not filed a Response. Paragraph B10(a) of the ADR Rules states that if a Party fails to comply with any of the time periods established by the ADR Rules or by the Panel, the Panel shall proceed to a decision on the Complaint and may consider this failure to comply as grounds to accept the claims of the other Party. As per paragraph B10(b) of the ADR Rules, unless otherwise provided for in the ADR Rules, if a Party fails to comply with any provision or requirement under the ADR Rules, the Supplemental ADR Rules, or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate. Under paragraph B11(a) of the ADR Rules, the Panel shall decide on a Complaint on the basis of the statements and documents submitted and in accordance with the Procedural Rules.

The Complainant's arguments as to the existence of bad faith on the side of the Respondent are convincing. There is nothing on the face of the facts, statements, and documents in this matter suggesting the Respondent has registered the Domain in good faith. There appears to be no use of the Domain by the Respondent other than for the primary purpose of attracting Internet users, by creating an impression of the relevant site's legitimacy, while at the same time redirecting the users to other websites with pornographic content, with the aim of earning click-through revenue. Given the distinctiveness of the Trademark and the content of the redirect websites, it is clear that the Respondent registered the Domain in the knowledge of the Complainant and its business (incl. its product names).

All these elements lead to the conclusion that the Respondent has intentionally attempted to attract Internet users to the Respondent's website (and to the redirect websites) for commercial gain by creating a likelihood of confusion with the Complainant's intellectual property as to the source, sponsorship, affiliation, or endorsement of such websites (paragraph B11(f)(4) of the ADR Rules).

Under the ADR Rules, the need to show no rights or legitimate interests on the part of the Respondent is an alternative, rather than an additional, requirement to establishing bad faith registration and use on the part of the Respondent. Accordingly, having satisfied sub-paragraphs (i) and (ii) of paragraph B11(d)(1) the Complainant succeeds in its case. However, for completeness, the Panel will briefly consider the issue of lack of no rights or legitimate interests.

In the opinion of the Panel, the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interest in the Domain. The Complainant has not licensed or otherwise permitted the Respondent to use the Trademark (or any other trademarks owned by the Group). Based on the evidence provided by Complainant, the Domain resolves to various websites containing pornographic content. This cannot be considered a bona fide offering of goods or services nor a legitimate and non-commercial or fair use of the Domain without intent to mislead consumers or harm the reputation of the Complainant. On the contrary, said use adversely affects the Complainant's business and reputation. Respondent is also not commonly known by the Domain nor has it acquired any trademark rights. Accordingly, the condition set forth under Paragraph B11(d)(1)(ii) of the ADR Rules is fulfilled.

The Panel, therefore, finds that all the requirements of paragraph B11(d)(1) of the ADR Rules are met.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the Domain <ATSelectrolube.eu> be revoked.

PANELISTS

Name Triin Toomemets-Krasnitski

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: ATSelectrolube.eu

II. Country of the Complainant: Canada, country of the Respondent: Latvia

III. Date of registration of the domain name: 8 April 2022

IV. Rights relied on by the Complainant on which the Panel based its decision:

Word trademark registered in EU, reg. No. 010201771, for the term until 17 August 2031, filed on 17 August 2011, registered on 28 December 2011 in respect of goods and services in class 7.

V. Response submitted: No

VI. Domain name is identical to the protected right of the Complainant.

VII. Rights or legitimate interests of the Respondent:

1. No

2. No licence or consent to the Respondent from the Complainant or other of its group companies to use the trademark; the Domain resolves to various websites containing pornographic content, which cannot be considered a bona fide offering of goods or services nor a legitimate and non-commercial or fair use of the Domain without intent to mislead consumers or harm the reputation of the Complainant; Respondent is also not commonly known by the Domain nor has it acquired any trademark rights.

VIII. Bad faith of the Respondent (B(11)(e) ADR Rules):

1. Yes

2. The Respondent uses the disputed domain for the primary purpose of attracting Internet users, by creating an impression of the relevant site's legitimacy, while at the same time redirecting the users to other websites with pornographic content, with the aim of earning click-through revenue.

IX. Other substantial facts the Panel considers relevant: None

X. Dispute Result: Revocation of the Domain.

XI. Procedural factors the Panel considers relevant: None

XII. [If transfer to Complainant] Is Complainant eligible? N/A
